

Remarks

Reconsideration of this Application is respectfully requested.

Claims 10, 11, 25, 26, 40, 41 and 58-63 are pending in the application, with claims 10, 25, 40, 58, 60 and 62 being the independent claims.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Telephonic Interview with The Examiner

Applicants thank the Examiner for the courtesy of a telephonic interview with the undersigned on April 12, 2004. During the interview, the rejections under 35 U.S.C. § 101 (double patenting) and 35 U.S.C. § 112, second paragraph, were discussed.

II. Double Patenting

Claims 10, 11, 25, 26 and 58-61 were rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1, 2, 10 and 11 of U.S. Patent No. 6,323,218. Applicants respectfully traverse this rejection.

As noted in Applicants' previous response, and as discussed in the telephonic interview with the Examiner on April 12, 2004, a patent cannot be used as a reference against an application in a double patenting rejection if: (a) the application is a divisional of

the parent application that resulted in the patent, and (b) the application was filed as a result of a restriction requirement in the parent application. This prohibition is clearly set forth in 35 U.S.C. § 121 and is discussed in M.P.E.P. § 804.01.

The present application is a divisional of U.S. patent application No. 09/038,154, which issued as U.S. Patent No. 6,323,218. The present application was filed as a result of a restriction requirement that was made in U.S. patent application No. 09/038,154. (The currently pending claims correspond to "Group II" as set forth in the restriction requirement in the parent application.) Therefore, under 35 U.S.C. § 121, U.S. Patent No. 6,323,218 cannot be used in a double patenting rejection against the claims in the currently pending application.

In addition to the fact that U.S. Patent No. 6,323,218 cannot be used as a reference against the present application in a double patenting rejection, Applicants also reiterate their position, as set forth in the previous response, that the claims pending in this application and the claims in U.S. Patent No. 6,323,218 do not define the "same invention." *See, e.g., In re Vogel*, 422 F.2d 438 (CCPA 1970); *see also* M.P.E.P. § 804, II, A.

In view of the foregoing, Applicants respectfully request that the rejection for statutory double patenting be reconsidered and withdrawn.

III. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 10, 11, 25, 26, 40, 41 and 58-63 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to point out and distinctly claim the

subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

The rejection under 35 U.S.C. § 112, second paragraph, is directed to the phrases "a chelator specific for copper" in claims 10, 11, 25, 26 and 40, and "a hydrophobic derivative of a chelator specific for the reduced form of copper" in claims 58, 60, 62 and 63.

According to the Examiner:

In the instant method, claims 10 and 25 fail to particularly point out the identity of the active agent (a chelator specific for copper) to be administered in the instantly claimed method. The current claim language is drawn to administering a compound, which is not described structurally/formulaically/nomenclatorially; however, the active agent's (a chelator specific for copper) mode of action, function or effect requisite to practicing the claimed method set forth. The claims are missing the critical element, which is particular or distinct identity of the active agent (a chelator specific for copper) to be used in the method claims. It is noted that the claims are limited to what the administration or use of "a compound" is intended to accomplish rather than what the active agent (a chelator specific for copper) actually represents as a chemical entity.

Paper No. 32, page 3. Similar assertions were made with respect to the phrase "a hydrophobic derivative of a chelator specific for the reduced form of copper."

The principle inquiry under 35 USC § 112, second paragraph, is whether a person of ordinary skill in the art would be apprised of the scope of the claims. *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). The Examiner has failed to explain why, from the perspective of one of ordinary skill in the art, the terms "a chelator specific for copper" and "a hydrophobic derivative of a chelator

specific for the reduced form of copper" render the scope of the present claims indefinite. Thus, a *prima facie* case of indefiniteness has not been established.

The Examiner has based the rejection on the use of generic language in the claims. (For example, the Examiner stated that: "[t]he claims are missing the critical element, which is [the] *particular or distinct identity of the active agent . . .*") Applicants note, however, that there is no *per se* prohibition against the use of generic claim terminology. *See, e.g., In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971) (Breadth of a claim is not to be equated with indefiniteness.); *See also* M.P.E.P. § 2173.04. In addition, the use of functional limitations in a claim cannot be the sole basis for a rejection under § 112, second paragraph. *See In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); *See also* M.P.E.P. § 2173.05(g). Accordingly, the reasons presented by the Examiner to support the rejection are legally insufficient to establish a *prima facie* case of indefiniteness.

The expressions "chelator," "hydrophobic derivative," and "reduced form of copper" are commonplace in the biological arts. Applicants therefore submit that the expressions "a chelator specific for copper" and "a hydrophobic derivative of a chelator specific for the reduced form of copper" would be clearly understood by a person of ordinary skill in the art without any ambiguity. Accordingly, the scope of the subject matter encompassed by the present claims would be fully appreciated by persons skilled in the art. Applicants therefore respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be reconsidered and withdrawn.

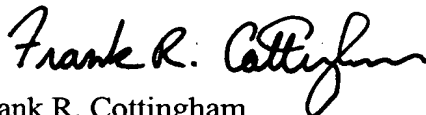
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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